

Appl. No. 09/558,945
Amd. Dated September 27, 2005
Reply to Office Action of May 27, 2005

REMARKS/ARGUMENTS

Reconsideration of the present patent application, as amended, is respectfully requested.

Of pending claims 1-17, 19-27, and 36-48, all were rejected.

The specification was objected to for not conforming to 37 C.F.R. §1.71. In particular, the Examiner stated that the specification failed to describe the limitation of the claimed invention, "prolonging the promoting beyond the predetermined time period..." which is "independent of availability of the first item" per independent claim 1. The Examiner found no reference in the specification as originally filed regarding the promoting (or the prolonging of it) being performed independent of the availability of the item being promoted. Furthermore, the limitation of claim 36, "detecting using said computer network system that said granting could not be performed by said computer network" and "responsive to said detecting ...recording a price paid... and granting a rebate of the difference...at said location," was objected to. The Examiner found no teaching in the specification as originally filed regarding the detecting step and recording and granting action performed in response to the detection.

Related to the objection to the specification, claims 1-17, 19-27 and 36-48 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the invention was filed, had possession of the claimed invention. In particular, claims were rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth in the objection to the specification.

In response, the applicant has canceled the objected to language in independent claims 1 and 46. These claims were also amended to include the language, "determining whether said identified consumer had made an acknowledgement of said promoting within the predetermined time period, said acknowledgement not including an attempt by said identified consumer to purchase said first selected item...", or similar language. Support for this language is found on the acknowledgement examples on page 7 of the applicant's specification. Additionally, in particular, see page 4, lines 22-23. "Rather requiring the consumer to act upon the offered

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promotion to obtain the discount (i.e., an attempt to purchase the promoted item), the present invention inverts this process (parenthetical expression added)."

With respect to the rejection of independent claim 36 under 35 U.S.C. §112, first paragraph, the applicant has amended claim 36 to better claim the invention to which he is entitled and directs the Examiner to the paragraph beginning on page 10, line 14. The applicant believes that the Examiner's concerns on this matter should be satisfied.

Claim 36 was also rejected under 35 U.S.C. §112, second paragraph, for indefiniteness. In particular, the Examiner found that claim 36 recited the limitation, "detecting...that said granting could not be performed by said computer network," while a preceding step, in contradiction, recited a step "granting said discount upon purchase of said first selected item". As stated in the previous paragraph, claim 36 has been amended and should address the Examiner's concerns on this issue.

Claim 20 was also found to be indefinite because the function "limiting an audio device" fails to functionally relate to any other step of the parent claims. The applicant is puzzled because the function, "limiting an audio device," does not appear in the claim. Nonetheless, the applicant has amended claim 20 to further relate the claim to its parent claims.

Therefore, the objections to independent claims 1, 36 and 46 (and dependent claim 20) should be removed.

Substantively, claims 1-5, 11-16, 19-27 and 37-48 were rejected under 35 U.S.C. §103(a) as being obvious over the PR Newswire article, "Caldor Announces Agreement with New York State Attorney General", dated January 11, 1993 (hereafter "Caldor") and further in view of U.S. Patent No. (hereafter "Scroggie"). The Examiner found that the applicant's determining step was analogous to "the customer wishes to purchase the advertised item at a sale price visits the store in response to the advertised sale price, the determination whether a customer desires to purchase the sale priced item to the store clerk during the sale period is the acknowledgement of the advertisement," found in the Caldor article.

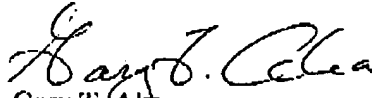
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As amended, independent claim 1 includes the limitation, "said acknowledgement not including an attempt by said identified consumer to purchase said first selected item." This distinguishes the applicant's invention from the Caldor article. The applicant's acknowledgement is not taught in the cited references and claim 1 should be allowable. Independent claim 46 should likewise be allowable.

Hence independent claims 1, 36 and 46 are patentably distinguishable over the cited prior art and are allowable. Dependent claims 2-17, 19-27, 37-45 and 47-48 should also be allowable for at least being dependent upon allowable base claims.

Therefore, in view of the amendments above and the remarks directed thereto, the applicant respectfully requests that all rejections be withdrawn, that claims 1-17, 19-27 and 36-48 be allowed, and the case be passed to issue. If a telephone conference would in any way expedite the prosecution of the application, the Examiner is asked to call the undersigned at (408) 868-4088.

Respectfully submitted,


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